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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,290	12/11/2000	George Bradley Hobbs	10003973-1	3711

7590 02/14/2008
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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02/14/2008

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE BRADLEY HOBBS

Appeal 2007-4198
Application 09/734,290
Technology Center 3600

Decided: February 14, 2008

Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-26 and 29-34. Claims 27-28 and 35-40 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We REVERSE.

THE INVENTION

The Appellant's claims are directed to a method of processing a print job of a customer and directing advertising to the customer. The method includes defining a print processing controller having an advertisement registered therewith, defining a network link between the customer and print processing controller, processing a job ticket for the print job, and presenting the advertisement to the customer via the network link when processing the print job (Specification 2). Claim 21 reproduced below is representative of the subject matter of appeal.

21. A system for processing a print job of a customer and directing advertising to the customer, the system comprising:
- a print processing system controller configured to have an advertisement registered therewith; and
 - a customer interface configured to communicate with the print processing system controller to transmit a job ticket for the print job to the print processing system controller,
- wherein the print processing system controller is adapted to process the job ticket for the print job and display the advertisement on the customer interface when processing the job ticket.

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejections:

Dutta

US 6,891,635 B2

May 10, 2005

The following rejection is before us for review:

1. Claims 1-26 and 29-34 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dutta.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in rejecting the claims 1-26 and 29-34 under 35 U.S.C. § 103(a).

This issue turns on whether it would have been obvious to modify Dutta to “display the advertisement on the customer interface when processing the job ticket” instead of on the printed documents.

FINDINGS OF FACT

We find the following enumerated findings of fact:

1. Dutta discloses a printing system in which advertisements are inserted into documents to be printed (Col. 3:24-45).
2. Dutta states that “[a] challenge with Internet based advertisements is that they only appear for a brief time to the user. Often when the user changes screens or visits another web page, they forget the information” (Col. 1:61-65).

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3)

the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). See also *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007) (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Examiner does not dispute that the Dutta reference does not disclose displaying the advertisement on the customer’s interface (computer screen or display) while receiving or processing the print job instead of printing the advertisement together with the customer’s document (Ans. 7).

The Examiner argues that the rejection under 35 U.S.C. § 103(a) is proper because one of ordinary skill in the art would have been motivated to modify Dutta to display the advertisements on the computer screen instead of printing them for cleaner printed output, to save paper and to reduce processing time (Ans. 11-12).

The Appellant argues that the Dutta reference teaches away from displaying advertisements (Br. 7-8) and that the rejection under 35 U.S.C. § 103(a) is not proper. The Appellant argues that Dutta teaches away from using advertisements such as banners on Internet web pages (Br. 7) and that the Dutta reference deals with subsidized printing in exchange for advertising space (Reply Br. 3). The Appellant argues “[m]odifying the Dutta patent ... to display the advertisement instead of plac[ing] the advertisements on the printout...would simply return the method...to the arrangement of the stated problem and result in the actual situation the Dutta patent is trying to overcome.” (Reply Br. 5.)

We agree that the Dutta reference does teach away from the proposed modification.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Dutta states the challenge of Internet based advertisements only appearing for a brief time and the user forgetting the information (FF 2). Dutta also states that if users do not write down the information or store it as a bookmark, they may not be able to remember the advertised goods or services (Col. 1:60-66). Given that the line of development in the Dutta reference is specifically directed to moving away from the disadvantages of using Internet advertising to using the advantages of printing advertisements instead, we find the reference to clearly teach away from the proposed modification in the rejection. The articulated reasoning for the proposed modification of Dutta in view of the reference itself teaching away is not sufficient to support the conclusion of obviousness.

As the Dutta reference applied in the rejection fails to “display the advertisement on the customer interface when processing the job ticket” instead of on the printed documents and teaches away from such a modification, we cannot sustain the rejection.

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CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-26 and 29-34 under 35 U.S.C. § 103(a) as unpatentable over Dutta.

DECISION

The decision of the Examiner to reject claims 1-26 and 29-34 is reversed.

REVERSED

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